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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,842	02/11/2002	Arturo A. Rodriguez	A-7496	6628
5642 7590 03/09/2007 SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044			EXAMINER BUI, KIEU OANH T	
			ART UNIT 2623	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/09/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/09/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

**Office Action Summary**

Application No.

10/073,842

Applicant(s)

RODRIGUEZ ET AL.

Examiner

KIEU-OANH BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters; prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 105,106,108-115 and 122-139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 105,106,108-115,122-139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Remark*

1. Claims 1-104, 107 and 116-121 have been previously cancelled, and claims 134-139 have been added. Pending claims are claims 105-106, 108-115, and 122-139.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 105-106, 108-115, and 122-139 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

4. Claims 105-106, 108-115, and 122-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent No. 6,898,762 B2) in view of LaRocca et al (US Patent 6,314,572 B1) and Mathai et al. (US Patent No. 6,847,969 B1).

Regarding claim 105, this limitation is met as Ellis discloses a method implemented by a television set top box or set top terminal (STT) comprising the steps of outputting to a television screen by the STT configured to identify advertisement categories, and under a user input at the STT for identifying or selecting a category of advertisements at the STT, the corresponding advertisements are provided to the STT responsive to the user input (see Fig. 3 for the set top box 23; col. 14/lines 42-52 for the user preferences on the advertisement category can be either

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stored within the set top box or at the server 25, and based on the user input for advertisement contents, the advertisement contents corresponding to an interested category is displayed to the user, refer to Figs. 5-6 for advertisement categories as Sports, Children, Music, Events, Premium etc.; and further in items 108 & 110 of Fig. 5 for selectable advertisements on different categories of programs and/or products, col. 10/lines 18-27). Ellis further discloses that advertisement category having a first advertisement category and a second advertisement category, and the user provides a first and a second input corresponding to the first category and the second category, and after receiving the first and second user inputs, outputting to the television screen by the STT the corresponding advertisements of the first and the second advertisement category at a first and second future time during an interruption in a television presentation being output by the STT (as shown in Fig. 9a as an example for a program will be displaying at certain times in the future using the start time and end time, even the segment of minutes can be selectable based on the user; and Fig. 21 at box 2070, Ellis clearly shows the target advertising is done based on preference user profile, refer to col. 20/line 63 to col. 21/line 39).

Ellis does not show the set top box includes a tuner therein; however, this is a must-have and known element within the set top box. Furthermore, Ellis does not show to provide “a menu having a plurality of viewer selectable advertisement categories”; however, in a same interactive programming delivering services to the user, LaRocca shows the set top box includes a tuner for tuning and providing television program to viewers (LaRocca, col. 6/line 57 to col. 7/line 14 for a tuner) and LaRocca further shows a menu having a plurality of viewer selectable advertisement categories for the viewer to choose from (Figs. 5 & 6 with an indication of “select a category”

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with a menu of plurality of selectable categories as indicated in Figs. 5 & 6, and col. 10/line 30-44). In further view, (since the applicants argue that the selectable categories herein is for subscription-on-demand (SOD) not for advertisements), Mathai teaches to offer the user selectable advertisement categories for the user to select which advertisement category to view (refer to Mathai, Figs. 1-3, and col. 9/lines 20-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellis' system with LaRocca's known technique of further including a tuner within the set top box and the displaying of a menu having a plurality of selectable categories with further teaching of Mathai's in offering selectable advertisement categories in order to provide the tuning to appropriate channel television programs and at the same time providing a menu with selectable advertisement categories to the user as taught by the combination of LaRocca and Mathai.

As for claim 106, this limitation is met as Ellis shows in Fig. 2c and 3 that the user uses a remote control 40 interacts with the set top box 28, which receives the video and data in 26 from a remote database, as shown in Fig. 2c with program guide server 25 at television distribution facility 16 (col. 5/line 24 to col. 6/line 50 for further details of interest).

(Claim 107 was canceled).

As for claim 108, this limitation is met as Ellis discloses that based on the scheduled time, the advertisement can only be targeted to right viewers based on their preferences and profiles from the set top or the user prior to receiving the user input (as shown in Fig. 9a as an example for a program will be displaying at certain times in the future using the start time and end time, even the segment of minutes can be selectable based on the user preset—defined prior

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to the user inputs; and Fig. 21 at box 2070, Ellis clearly shows the target advertising is done based on preference user profile, refer to col. 20/line 63 to col. 21/line 39).

As for claim 109, this limitation is met as Ellis discloses in Fig. 20b as the set top box offer a request whether the user selects the request or not as the third viewer input responsive to a request by the set top box.

As for claim 110, this limitation is met as Ellis discloses further comprising outputting the advertisement to a television during an interruption of the presentation of a television program having predetermined program categories (Fig. 22 as the user can define a preset additional information, i.e., software, internet links or videos, relate to the future broadcast programs based on his/her preferences).

As for claim 111, this limitation is met as Ellis further discloses that various attributes associated with groups of the advertisement categories as the subcategories of advertisements that correspond to respective broader categories (Fig. 21/at steps 2004, 2006, 2008).

As for claims 112 and 113, these limitations are met as Ellis further discloses that advertisements has defined duration display times, and they are stored within the set top terminal (Fig. 9A and col. 14/lines 47-51 for the preferences about advertisements can be stored in the client or user device).

As for claims 114 and 115, these limitation are met as Ellis discloses that as soon as the user click through or viewed the advertisements, the advertisement can be removed based on the log of committed advertisements using the weight value as a measurement of user activities whether to select the advertisements for viewing or not (Fig. 24 for track viewing history, and the

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target advertising is based on viewing history, refer to col. 19/line 10 to col. 20/line 31 & col. 23/line 30 to col. 24/line 5).

(Claims 116-121 have been previously cancelled).

As for claims 122-133, these claims with same limitations addressed earlier are rejected for the reasons given in the scope of claims 105-106, and 108-115 in view of Ellis and LaRocca as disclosed in details above. In addition to claim 122 and claim 128, Ellis does not further show to provide "a menu having a plurality of viewer selectable advertisement categories" (as argued by the applicants); however, in a same interactive programming delivering services to the user, LaRocca further shows a menu having a plurality of viewer selectable advertisement categories for the viewer to choose from (Figs. 5 & 6 with an indication of "select a category" with a menu of plurality of selectable categories as indicated in Figs. 5 & 6, and col. 10/line 30-44). In further view, (since the applicants argue that the selectable categories herein is for subscription-on-demand (SOD) not for advertisements), Mathai teaches to offer the user selectable advertisement categories for the user to select which advertisement category to view (refer to Mathai, Figs. 1-3, and col. 9/lines 20-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellis' system with LaRocca's known technique of further including a tuner within the set top box and the displaying of a menu having a plurality of selectable categories with further teaching of Mathai's in offering selectable advertisement categories in order to provide the tuning to appropriate channel television programs and at the same time providing a menu with selectable advertisement categories to the user as taught by the combination of LaRocca and Mathai.

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As for claims 134-139, in further view of claim 105 above, LaRocca further shows that the advertisement comprises a commercial and/or selectable advertisements or a combination of both (LaRocca, Figs. 5 & 6 and col. 10/lines 30-44 as the advertisement is either for selectable advertisement or commercial, as a "special value package" represents a commercial product which solicits for a sale).

***Conclusion***

**5. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to PTO New Central Fax number:**

(571) 273-8300, (for Technology Center 2600 only)

Hand deliveries must be made to Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

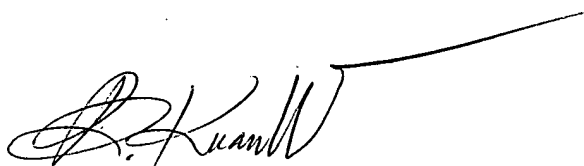
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending to the right.

Kieu-Oanh Bui  
Primary Examiner  
Art Unit 2623

KB  
Feb. 09, 2007